

REMARKS

Reconsideration of this application and the rejection of claims 41-57 and 61-63 are respectfully requested. Applicants have attempted to address every objection and ground for rejection in the Office Action dated August 8, 2007 (Paper No. 20070804) and believe the application is now in condition for allowance. The claims have been amended to more clearly describe the present invention.

A Request for Continued Examination accompanies this communication.

New FIG. 12 is enclosed herewith. This drawing shows a hole on the outer edge of the tray. The hole is a means for releasing trapped air from between the members claimed in claim 55. Support for this amendment is found on page 12, lines 23-29 of the application. This paragraph is being amended merely to show the associated reference numerals. No new matter is believed to be introduced by these changes.

Claims 47 and 56-57 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and for failing to particularly point out and claim the invention. The “acrylic layer” of claim 47 has been amended to read “acrylic cap” as referenced in claim 46, to which the Examiner had no objection. As to the objections to claims 56-57, “said filler material” was corrected in Amendment A in claim 56. There was no previous objection to claim 57, but it is being corrected to read “filler” in place of “filler material”.

Claim 63 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and for failing to particularly point out and claim the invention. It is stated in the

Office Action that there is insufficient antecedent basis for “said...lower members” in lines 4-5. Applicants respectfully point out that “an upper member” is introduced in line 1 of the claim and “a lower member” is introduced in line 3 of the claim. Proper antecedent basis is thus provided. The Examiner is respectfully asked to withdraw the rejection or more fully explain any deficiency upon which the rejection is based.

Claims 41-42, 44-57 and 61-63 stand rejected under 35 U.S.C. 102(b) as being anticipated by Altman et al. (US 4,067,071). Altman discloses a retrofittable bathtub liner including a plastic liner body, corresponding wall liners, and a filler material. In Altman, upon installation, the liner rests directly upon the bottom wall of the tube cavity (Col. 5, lines 39-43). It is suggested that Altman fails to reveal at least two aspects of Applicant’s invention, therefore Applicant traverses the rejection.

At least two features of each of the present claims are absent from Altman. The gap of Altman is not constructed and arranged to separate the upper member from the lower member. Altman repeatedly states the criticality of having the bottom wall of the liner rest directly on the bottom wall of the tub cavity. See, for example, FIG. 7, the Abstract, ll. 4-7 (“liner having a tub portion sized to be seated in the tub cavity of the bathtub and with the bottom surface of the tub portion resting upon the bottom surface of the original tub cavity”), col. 2, ll. 53-54 (“with the bottom wall of the bathtub liner resting on the floor of the original bathtub”), col 5, ll. 39-44 (“the bottom wall 54 of the liner rests directly upon the bottom wall 34 of the tub cavity 22”), col. 6, ll. 24-29 (“since the bottom wall 54 of the liner

12 rests firmly upon the bottom wall 34 of the bathtub cavity 22”) and col. 6, ll. 66-69 (“with the bottom wall of the insert resting upon the bottom wall of the bathtub”). The gap of Altman happens to occur where the contours of the liner do not match those of the tub, but it is not designed to separate the liner from the tub.

Further, the core of Altman does not support substantially the entire undersurface of the liner. Altman makes it clear that “a major part of the weight of the liner, as well as that of the water and the bather therein, is supported by the bottom of the original tub.” (col. 6, ll. 26-29). Referring to the citations in the prior paragraph, it is clear that the liner of Altman is not supported in its entirety by the filler material. Altman verifies the criticality of this arrangement by further stating that “[t]his has a decided advantage over bathtub inserts wherein the insert is suspended within the tub with the insert ledges resting upon the tub ledges and the bottom of the insert spaced above the bottom of the tub.” (Col. 6, ll. 33-37). FIG. 7 shows that the bottom of the liner is substantially supported by the bathtub along the entire length of the unit.

Applicants have discovered a way to stably support the insert without supporting the weight of the liner, liner, bather and water directly on the lower member. Thus, at least two features of each of the present claims are not shown by Altman. In fact, Altman teaches away from Applicants’ claims by requiring that the bathtub bottom support the weight of the liner, water and bather. Since the rejection has been traversed, Applicants respectfully request that the rejection be withdrawn.

Regarding the rejection of claims 52-56, Applicants responded to the previous Office Action by pointing out that means plus function claims are appropriate claims for the subject apparatus claims. In reply, the Examiner states “the phrases do not positively set forth any further structural limitations than those already discussed above and below.” However, 35 U.S.C. § 112, paragraph 6 states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

A properly constructed means plus function claim cannot contain structural limitations, yet functional claiming is a valid method of describing features of an invention. Claim 52 includes a locating means which are not included in any prior claims. In claim 53 the locating means is specified as cooperating formations on the upper and lower members. This is not a functional claim, since it specifies a structural limitation, but it does refer to the means plus function of the claim from which it depends. It also positively sets forth a structural limitation not specifically claimed elsewhere. Claims 54 and 55 refer to a “means to release air” and a “means to assist distribution of said filler”, respectively. They are also clearly means plus function claims.

The claims have been amended to use the transitional phrase “further comprising” to more specifically point out the new features being introduced. Since the

phrases to which the Examiner objects are clearly means plus function claims, he is asked to withdraw the rejection or more clearly specify the language upon which the rejection is based.

The Examiner states that Altman teaches in col. 4, ll. 12-23 that the lower member is made of acrylonitrile as is claim 48. The citation provided here refers only to Altman's liner, which is analogous to the upper member of Applicants' claims. Applicants find no reference as to the composition of the lower member (or bathtub) of Altman. Thus the feature of this claim is not anticipated by the reference.

Regarding claims 50-51, Altman fails to disclose sockets on the underside of the lower member for receiving legs. The Examiner has pointed to the drain pipe of FIG. 7, the rear side wall of the bathroom and the vertical skirt that extends to the floor in FIG. 4. None of these is a socket. The bathtub could be at least partially supported by the bathroom wall or the vertical skirt. Perhaps the Examiner was thinking that these would function as legs. Even if this were correct, neither reveals the use of a socket for receiving the legs. Applicant submits that, for at least these reasons, claims 50-51 are not anticipated by the wall, front skirt and drain pipe of Altman.

In rejecting claim 57, FIG. 4, #56 is suggested as being analogous to the interlinked recessed regions of the lower member that allow the filter material to flow freely between the members. However, #56 is the filler material itself and not a feature of the lower member. There are no interlinked recessed regions in the gap, only the gap itself.

Thus there is no showing that the additional features of claim 57 are taught by Altman, and this reference cannot anticipate the claimed invention.

Regarding claims 62 and 63, Applicant submits that these claims are not anticipated by Altman. Altman fails to show, at least, a lower member of plastics material on an underside of the tray. Arguments asserted above with respect to claim 48 are reasserted here. The Examiner further points to the front skirt of the liner that is made as the same material as the liner. However, the front skirt is not part of the underside of the tray. It is used to face the vertical skirt of the bathtub. There is no teaching or suggestion that either the bathtub or the vertical skirt is made of plastic material.

Claim 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Altman in view of Swanson (U.S. Patent No. 4,414,385). It is maintained that Swanson is not analogous art. Applicants further submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Altman and respectfully traverses the rejection.

According to the MPEP. § 2141.01(a), prior art relied upon must be analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In the "Answers to Applicant's (sic) Arguments" it is stated that "Altman ('071) and Swanson ('385) are both directed towards cement-like formulations[.]" Whether the two pieces of prior art are related

to each other is irrelevant, only how each reference is related to the present application matters.

According to the Swanson, the invention relates to sulfur modified cements used as a lining material for concrete structures, particularly concrete pipes. The present invention does not relate to sulfur modified concretes or anything as a mining material for concrete structures. Thus it is not the same field of endeavor. Nor is it reasonably related to the particular problem with which the inventor was concerned. In this case, the inventor is trying to build a better shower tray, in particular, a shower tray that does not have a rough surface on the underside of the tray. Neither of these problems is addressed in either Swanson or Altman.

Even if the references are analogous, no *prima facie* case of obviousness has been established. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Second, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488,

20 USPQ2d 1438 (Fed. Cir. 1991). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Finally, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

No motivation to combine the references has been provided in either of the references. It is asserted that Swanson discloses the use of dicyclopentadiene resin for the purpose of providing a material with superior resistance to chemical attack. However, there is no disclosure in Altman of the use of the bathtub or shower in chemically adverse conditions. Nor does Altman have a concrete structure in need of protection by a sulfur modified cement as lining. Thus, there is no motivation to combine these references.

Even if these references were combined, there is little expectation of success in such a combination. Swanson reveals preparation of a coating that is sprayed on concrete. There is no teaching or suggestion that this composition would be useful as a filler material of various thicknesses. As Altman does not reveal the use of a concrete structure, there is no



guidance where the coating of Swanson would be used. The coating of Swanson involves a complicated formulation procedure performed at high temperatures and relatively long (30 hour) curing times which are incompatible with the present application. It is also unlikely that the composition of Swanson would be catalyzed using the catalyst proposed by Altman. Thus, there is little expectation of success in combining Altman with Swanson to produce the instant claims.

Finally, the arguments asserted above traversing Altman are reasserted here. Thus, at least two elements of claim 43 are absent from the combination of Altman with Swanson. Thus, since there is neither motivation to combine, expectation of success nor a recitation of all claim elements of Applicants' amended claims, no *prima facie* case of obviousness has been established. Applicants respectfully request that the rejection be withdrawn and the subject claim allowed.

Applicants respectfully suggest that in the outstanding Action, the rejections evidence "picking and choosing" features of various references and combining them when there is no suggestion in those references to do so. It is impermissible within the framework of a 35 U.S.C. § 103 rejection to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. Furthermore, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination.


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Teachings of references can be combined only if there is some suggestion or incentive to do so. None of these references, whether cited or of record, taken either alone or in combination, disclose or suggest the invention as claimed. The references do not teach, suggest or exemplify the shower tray claimed by Applicants.

Applicants submit that in view of the above-identified amendments and remarks, the claims in their present form are patentably distinct over the art of record. Allowance of the rejected claims is respectfully requested. Should the Examiner discover there are remaining issues which may be resolved by a telephone interview, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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